

REMARKS

Claims 1-43 were pending in the application. Claims 1-10, 14, 15, 17, 22, 24, 26, 28, 31, 33-35, 37, 38 and 41 have been cancelled without prejudice to presentation in future related applications. Claims 11-13, 16, 18, 19, 20, 21, 23, 25, 27, 29, 36, 39, 40 and 42 have been amended. New claims 44-54 have been added.

The claims have been amended to further clarify the claimed invention and to claim specific embodiments of the invention. Support for the amendments can be found throughout the application as originally filed, including, for example, in the as-filed claims, page 10, line 29 to page 11, line 1, pages 16, line 28 to page 17, line 22, page 18, lines 25-28, and page 50.

New claims 44-47 further defines the cDNA molecule disclosed in claims 11, 13 and 16. New claims 48 and 49 describe the polypeptide encoded by the elected polynucleotides. New claims 50-54 recite methods of making recombinant vectors, recombinant host cells and polypeptides and the recombinant vectors, host cells and polypeptides so produced.

No new matter has been added.

Upon entry of this amendment, claims 11-13, 16, 18-21, 23, 25, 27, 29, 30, 32, 36, 39 and 42-54 will be pending.

Preliminary Matters

Applicants wish to thank Examiner Martinell for the helpful comments and suggestions provided to the undersigned in a recent telephone conference regarding the withdrawal of the November 15, 2005 Restriction Requirement.

Restriction Requirement

Claims 1-43, all the pending claims, are again subject to a restriction requirement. The Office indicated that an earlier requirement for restriction mailed November 15, 2005 was vacated. In the November 15, 2005 Action, Applicants were required to elect one of five allegedly distinct inventions and to "select no more than *ten* of the individual sequences for

examination.” (emphasis added). Applicants previously elected Group III, drawn to nucleic acids and host cells and selected SEQ ID NOS: 1, 4, 5, 10, 11, 15, 16, 17 and 18 for examination.

In the present Action the Office requires Applicants to elect one of five allegedly patentably distinct inventions for examination and has required the election of *one* SEQ ID NO for examination. Applicants respectfully traverse on the grounds that searching more than one of the groups set forth by the Office would pose no serious burden on the Office. Further, Applicants note that they had detrimentally relied on the previous Office Action in formulating a patent prosecution strategy and will incur additional expenses in responding to this further Restriction Requirement. Accordingly, Applicants suggest that more than one sequence be searched and examined to the extent that no serious burden is imposed on the Office. Applicants therefore propose the search and examination of two sequences (SEQ ID NOS: 1 and 11) as set forth in the revised claim set included herein.

MPEP §803 sets forth criteria for determining when restriction is proper, stating, *inter alia*, that “[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.” Applicants respectfully assert that searching more than group, in particular, Groups III and V, would not constitute a serious burden. Applicants note that both of Groups III and V relate to specific elected nucleic acids and include the feature that each sequence is expressed at higher levels in metastatic breast cancer samples compared to non-metastatic breast cancer samples. Accordingly, search results for Group III would be highly relevant to Group V and *vice versa*.

Although Applicants respectfully traverse the restriction requirement on the grounds that examining more than one invention would not constitute a serious burden, Applicants elect herein “Group III, Claims 11-28 and 36-41, drawn to nucleic acids and host cells, classified in class 530, subclass 23.5 and class 435, subclass 252.3”. Applicants elect for examination SEQ ID NO:1. New claims 44-54 are encompassed by elected Group III.

As discussed above, Applicants respectfully request the search and examination of SEQ ID NOS:1 and 11. Applicants note that the two sequences elected are both expressed at a higher level in metastatic breast cancer tissue relative to non-metastatic breast cancer tissue.

Notwithstanding the foregoing, however, Applicants respectfully request that Group V ("Claims 29, 32, 42 and 43, drawn to methods of analyzing nucleic acids, classified in class 435, subclass 6") be examined along with Group III. Including both Groups III and V in the present application would have the affect of minimizing the administrative burden on the Office of searching and examining two closely related Groups in separate applications.

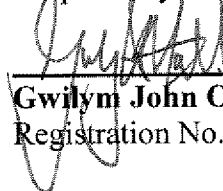
Applicants reserve the right to prosecute the claims encompassed by any of the non-elected groups in future divisional applications.

Conclusion

The examination of the pending claims and passage to allowance are respectfully requested. An early Notice of Allowance is therefore earnestly solicited. Applicant invites the Examiner to contact the undersigned at (302) 778-8458 to clarify any unresolved issues raised by this response.

Applicant requests that any charges or credits for filing this response be applied to Deposit Account No. 061050, refererencing Attorney Docket No. 20366-141002/PP01451.105.

Respectfully submitted,



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